



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,773	08/28/2001	Masaaki Ohashi	1007-011	6753

7590 05/23/2003

James V. Costigan, Esq.
HEDMAN & COSTIGAN, P.C.
Suite 2003
1185 Avenue of the Americas
New York, NY 10036-2646

EXAMINER

ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
----------	--------------

1771

DATE MAILED: 05/23/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 4/22/03
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-17 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 8, 10-17 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☒ The proposed drawing correction, filed on 4/22/03 is ☒ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Art Unit 1771

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 8 and 10-17 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, despite the recent claim amendments applicant's claim 8 is still believed to be vague, indefinite and confusing since the preamble to the claim appears to recite three elements and the "comprising" section appears to recite two different elements which are adhered to one another by utilization of laser spot welding. No relationship between these elements is set forth anywhere in the claim, and it is also not clear that there inherently exists any relationship between the various elements. Additionally, it is further noted that certain of the dependent claims also add additional structure to the structure of the embodiment set forth in claim 8 which in some cases make the claim even more vague, indefinite and confusing than presently exists.

3. Claims 8 and 10-17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over applicant's admissions regarding the prior art as set forth in either Japanese -681 or Japanese -300 as set forth in the specification at pages 2, 3 and 4 taken either individually, or in view of either Lin et al. or Kobori, substantially for the reasons set forth in paragraph No.

Art Unit 1771

8 of Paper No. 7, together with the following additional observations. Applicant's claim 8 is now in essence a product-by-process claim, requiring the "peeling sheet" adhered to the "support member" with YAG laser spot welding. Initially the Examiner notes that "all of the welding limitations" are in essence product-by-process in nature, and the Examiner initially reiterates his earlier contention that laser spot welding is also believed to be an obvious modification to one of ordinary skill. Alternatively, ^{as evidence of the state of the art} note also ^ALuc, which discloses (note particularly column 1 lines 30-37, column 4 lines 12-21, lines 32-48, column 6 line 64 - column 7 line 6, column 9 lines 1-22, column 11 line 60 - column 12 line 5, Example 7) throughout its disclosure that a broad genus of fluoropolymers and related polymeric materials (applicant's preferred) can be bonded to a broad genus of metals by welding techniques. Although applicant has claimed a specific type of laser spot welding, and has also included what essentially constitutes a Declaration comparing other types of welding (electrical welding and CO₂ laser welding) it must be noted that these comparisons are not against the "closest prior art" i.e. as set forth in Luc and also that it is further noted that "welding" constitutes a very broad genus of techniques which can be utilized to bond a broad genus of one type of substrate (e.g. fluoropolymers or other polymeric sheets) to another type of substrate (e.g. metals). Finally, it is again noted that the

Art Unit 1771

thicknesses of the PTFE sheet (Response, page 4, bottom paragraph) are believed to be well within the ordinary skill of the art, in the absence of unexpected results. In essence, applicant has not rebutted the prima facie case of record.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner

Serial No. 09/940,773

-5-

Art Unit 1771

can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

May 21, 2003

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1900-
1700

Daniel Zirker